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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,317	12/06/2001	Srinivas Guddanti	10016586-1	4745

22879 7590 11/29/2004

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EXAMINER

LEE, SUSAN SHUK YIN

ART UNIT	PAPER NUMBER
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2852

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/016,317	Applicant(s) GUDDANTI ET AL.	
	Examiner Susan S. Lee	Art Unit 2852	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11, 14-16, 18-21 and 23-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11, 14-16, 18-20, 23, 26-28, 32, 33 and 35 is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 6-10, 21, 24, 25 and 34 is/are rejected.
- 7) ☒ Claim(s) 2 and 29-31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Austin et al. (6,665,089).

Austin et al. discloses a printing system having a portable printer that produces hard copies (note column 1, lines 29-14). The printing system measures at least one external condition. The external condition could be an environmental condition at the locality of the print system. For instance, the external condition could be the environmental temperature, barometric pressure, atmospheric pressure, dew point, or any other climatic condition that might affect the operation of the printer system. Note column 14, lines 19-52. Since the printing system measures environmental conditions such as the ones listed before, Austin et al. implies that there are some devices used to measure temperature, barometric pressure, and so forth. These devices would read on the instant invention's "environmental sensor configured to monitor at least one environmental condition proximate to the image forming device and to provide data indicative of the at least one environmental condition". The environmental conditions

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are measured by circuitry in a computer communicatively coupled thereto the printer (note column 15, lines 41-46). This is reads on the instant invention's "an interface configured to communicate the data indicative of the at least one environmental condition externally of the image forming device". If the environmental conditions are measured by circuitry in a computer coupled to the printer then the computer must somehow output the measurements to the printer so that the print settings or printer operating conditions can be set according to the measured external condition. Note column 14, lines 41-52. This reads on the limitations in claim 34. The printing system has a hardware system 1200 and the printer 100 that may receive operational power from battery 1224 during portable operation of printer 100. Note column 7, lines 35-40.

Claims 1, 3, 4, 6, 7, 9, and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Dougherty et al. (6,641,244).

Dougherty discloses an electrophotographic printer 105; an environmental sensor 150 connected to a network 145 that could be a local area network or the Internet that senses environmental conditions (ECs) in the general vicinity of the printer 105 (note column 3, line 65 – column 4, line 21); the printer's interface 110 is connected to controller 120; and the printer's memory 125. The printer's process may be performed utilizing previously measured environmental conditions (ECs). Note column 6, lines 5-10. This implies a showing that there is a history of measured environmental conditions that is stored in the printer's memory so that a process of the printer can be performed using previously measured environmental conditions as disclosed by Dougherty (column 6, lines 5-10). A toner usage is also determined for the printer 105

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and a look up table of the toner usage is used for common environmental conditions.

Note column 5, lines 17-48. Controller 120 may be operable as an imbedded Web server and capable of searching for information via various types of networks (claim 4).

Note column 3, lines 57-62. The printer is connected to the network 145 that is external of the image forming device. This network 145 reads on the instant invention's client device external of the image forming device (claim 4) or on the instant invention's device external of the image forming device (claim 3). Environmental conditions include relative humidity, temperature, and barometric pressure. Note column 1, lines 46-60.

The controller 120 may be configured to find and poll one or more sensors 150 in the vicinity of the printer 105; and to receive the environmental conditions for the general vicinity of the printer 105 from a Web page provided by the network 145. Note column 3, lines 62-64 and column 4, lines 13-21. The environmental conditions may be measured before the print job is generated, after the print job has finished printing, and/or any time in between. Note column 4, line 63-column 5, line 11.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 21, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. in view of Nakane et al. (5,148,218).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Dougherty, as discussed above, differ from the instant invention by not disclosing an internal power source to provide power to the sensor in an absence of power from a source external of the image forming device.

Nakane et al. discloses a humidity detector 100, a temperature detector 101, timer 121, coding circuit 122, memory controller 123 and memory 124 in an image

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forming device are always applied night and day with a drive voltage by the chargeable battery 120. Note column 10, lines 61-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Dougherty with that of Nakane et al. so that the environmental sensors and storage of data are always operating whether there is power or not supplied from outside of the image forming device.

Claims 1, 6, 8-10, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austin et al. (6,665,089) in view of Asai (Japan, 504).

Austin et al. as discussed above, differs from the instant invention by not disclosing a memory to provide a history of the at least one environmental condition to which the image forming device has been exposed.

Asai discloses a printer with a controller 6 that selects at the time of a replenishment of a developing unit 4 with new toner, electrification values for a photoreceptor 1 corresponding to a history of detected temperature and detected humidity detected by an environment sensor 19 for a specified time at every interval of the specified time. Note abstract. Since there is a history of detected temperature and detected humidity, this implies that there is a memory to store such a history so that past detected temperatures and detected humidity can be retrieved to be used to determine the electrification values.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Austin et al. with that of Asai so that optimal images can be obtained with a new replenishment of toner.

Response to Arguments

Applicant's arguments with respect to claims 21 and 34 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 8/30/04 have been fully considered but they are not persuasive. Applicant argues that there is no teaching or suggestion in Dougherty to "utilize a history of ECs". First of all, this language is not claimed in the instant invention with regards to claim 1. As stated in column 6, lines 5-10 of Dougherty, the printer's process may be performed utilizing previously measured environmental conditions (ECs). "History" as defined by Merriam-Webster Dictionary is events from the past. "Previous" as defined by Merriam-Webster Dictionary is prior to or going before. Thus, the "previously measured EC(s)" implies that these environmental conditions were measured before the present time or in another words measured from the past, thus creating a history. Although Dougherty discloses updating the EC(s), it is not true all the time. The update only occurs when the EC(s) from the past (history) have changed. Otherwise, the data from the past (history) will be used. Note column 5, line 66-column 6, line 10. Since the language in claim 1 merely states "a history of the at least one environmental condition to which the image forming device has been exposed", Dougherty shows the same as discussed above. Applicant has not shown any differences between the instant invention as claimed and the prior art to Dougherty.

Applicant argues that Dougherty cannot qualify as art under 102(e) because the applied reference has a common assignee with the instant application. This is not sufficient. See MPEP § 706.02(I)(1) and § 706.02(I)(2). There must be a showing that

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the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Applicant has not shown this yet.

Allowable Subject Matter

Claims 2, 29, 30, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Claims 11, 14-16, 18-20, 23, 26-28, 32, 33, and 35 are allowed over the prior art of record.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sato (Japan, 201) discloses a printer and two host computers that output environment information to the printer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan S. Lee whose telephone number is 571-272-2137. The examiner can normally be reached on Mon. - Fri., 10:30-8:00, Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Art Grimley can be reached on 571-272-2136 or 571-272-2800 (Ext. 52). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susan S. Lee
Primary Examiner
Art Unit 2852

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